



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/801,464 02/18/97 FUNAKOSHI A CFO-11946-US

005514 OM12/0927
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NEW YORK NY 10112

EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 09/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/801,464

Applicant(s)
Funakoshi et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Jul 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) 2, 5, and 13-34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3, 4, and 6-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendment filed July 10, 2000 has been entered. Upon careful reconsideration, the indicated allowability of the claims is withdrawn in view of the reference(s) to Gautron. Any inconvenience caused by this action is regretted. Accordingly, this Office action is being made **non-final**. The new rejections follow.

Election/Restriction

2. Claims 2, 5 and 13-34 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Claims 2, 5 and 13 have been withdrawn for the reasons previously described. Claims 14-34 are withdrawn because they are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These claims are directed monitor lines and the specifics thereof, wherein the monitor lines are not required for the patentability of the elected group as evidenced by the omission thereof and vice versa.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4, 6, 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gautron.

Gautron discloses a cutting method with every step of the claimed process including cutting a substrate (e.g., T) having a slice line (e.g., D) and a guide line which is an electrode line/layer (e.g., 13), and detecting a position of the guide line (e.g., with 15, 16) and correcting the cutting position.

In the alternative, if it is argued that the specific sheet material on which the process disclosed by Gautron is used is a metal sheet which cannot be characterized as a substrate, it is the Examiner's position that Gautron discloses a process for accurately cutting along a line in a sheet

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of material. It would have been obvious to one having ordinary skill in the art to use the process disclosed by Gautron on any type of sheet material or even more generally flat material to gain the advantages taught by Gautron.

Claim Rejections - 35 USC § 103

6. Claims 3, 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautron.

Gautron lacks the slice line and guide line being simultaneously formed, lacks an electrode line on the substrate in addition to the electrode layer, and lacks the slice line comprising an electrode line. However, these features appear to be matters of design choice to one having ordinary skill in the art and appear to lack criticality. For example, the slice and guide lines being formed at the same time appears to have no impact to the cutting process or its results. Similarly, the step of forming an electrode line appears to have no impact to the cutting process or its results particularly since the electrode line is not included in any active process steps. Similarly, the slice line comprising an electrode line appears to have no impact to the cutting process or its results particularly since there is no detection of the slice line and further since the slice line is cut away.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
September 25, 2000